

Notice of Allowability

Application No.

10/024,204

Examiner

Callie E. Shosho

Applicant(s)

ISOGAWA ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 11/24/03.
2. ☒ The allowed claim(s) is/are 1-6.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Callie E. Shosho
Primary Examiner
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Statement of Reasons for Allowance

1. The present claims are allowable over the “closest” prior art Fujii et al. (U.S. 5,929,140) and Isogawa et al. (U.S. 6,551,395) for the following reasons:

Fujii et al. disclose method of printing coating composition onto substrate using a composition comprising acrylic resin having OH groups, isocyanate, crosslinking agent, β -diketone, and coloring agent containing metal. However, there is no disclose or suggestion in Fujii et al. of printing a mark on a surface of a golf ball comprising a printing process using an ink wherein the process comprises the steps of applying the ink to a pad so that the pattern of the mark is formed on the pad with the ink and pressing the pad against the surface of the golf ball to transfer the ink forming the pattern of the mark from the pad to the surface of the golf ball as required in all the present claims.

Isogawa et al. disclose method of printing a mark on a surface of a golf ball comprising a printing process using an ink comprising a resin having an hydroxyl group, an isocyanate, and coloring agent containing a metal such as phthalocyanine blue, metal powder, silica, etc. The ink is printed on the golf ball by pad printing technique wherein the ink is applied to a pad so that the pattern of the mark is formed on the pad with the ink and then pressing the pad against the surface of the golf ball in order to transfer the forming the pattern of the mark to the golf ball.

However, as set forth in amended 35 USC 103(c), subject matter which qualifies as prior art under one or more subsections (e), (f), and (g) of section 102 cannot be applied against the claimed invention if the prior art and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

This rule change to 103(c) applies to any patent application filed on or after November 29, 1999.

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See Official Gazette, April 11, 2000. As noted in the Official Gazette, the “mere filing of a continuation application on or after November 29, 1999 will serve to exclude commonly owned 102(e) prior art that was applied, or could have been applied, in a rejection under 103 in the parent application.”

Given that the filing date of the present application is subsequent to November 29, 1999, that Isogawa et al. qualifies as prior art under 102(e), and that applicants have established that the present invention and Isogawa et al. were, at the time that the present invention was made, commonly owned, Isogawa et al. is disqualified as prior art against the present claims.

It is noted that the present specification provides comparative data wherein ink within the scope of the present claims, i.e. comprising β -diketone, is compared with ink outside the scope of the present claims, i.e. comprising no β -diketone. It is shown that the ink of the present invention is superior in terms of pot life and/or printability.

In light of the above, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

NOTE: As disclosed by applicants in the amendment filed 11/24/03, JP 2001-262034 is in the same patent family as Isogawa et al. (U.S. 6,551,395) and thus, could be used, instead of Isogawa et al., to reject claims 1-5 and 7 in combination with Uraki et al. (U.S. 5,972,087) (see paragraph 5 of the office action mailed 7/24/03).

However, such rejection is not envisaged given that the filing date of JP 2001-262034 lies between the filing date and the priority date of the present application as seen below:

Application No. 10/024,204 *priority date* – 1/12/01

JP 2001-262034 *filing date* – 9/26/01

Application No. 10/024,204 *filing date* – 12/21/01

Under MPEP 706.02(b), rejections based on 35 U.S.C. 102(e) can be overcome by perfecting the filing date of the priority document. Applicant's submission of amendment containing a certified priority document on 12/21/01 and its English language translation on 11/24/03 results in the perfection of the foreign priority filing date. Thus, JP 2001-262034 is not applicable against the present claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/4/04